

REMARKS

Reconsideration of the subject application in view of the above amendment is respectfully requested.

By the present amendment, claim 1 has been amended. Support for the amendment to claim 1 is found on page 6, paragraph 1, page 8, paragraph 1 and page 6, paragraph 2, and the last sentence of the specification. No new matter has been added.

Based on the foregoing amendment and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has requested that Applicants provide an Information Disclosure Statement listing the references cited in the specification. Applicants respectfully submit that the references cited in the specification are already in the record as they were cited by the Examiner in the instant Office Action of December 23, 2004. Accordingly, the Applicants respectfully request that the Examiner's requirement that Applicant submit an Information Disclosure Statement citing such references be withdrawn.

The Examiner has rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over Olvera et al (US Patent No. 5,897,045) (Olvera) in view of

Lin (US Patent No. 6,779,697). Applicants respectfully disagree with this rejection.

It is respectfully submitted that the present invention, as defined in independent claim 1 and claims 2-8 that depend therefrom, would not be obvious over such references.

Lin discloses a pneumatic nailer comprising a piston received in a body, a barrel rotatable and movable held to the body and a magazine connected to the barrel. The magazine with the barrel can be rotated relative to the body for operating the tool around obstacles.

Lin does not show a head piece being rotatable relative to the pipe arrangement and the rest of the drive-in device, as recited in claim 1 as amended. In contradistinction to claim 1, Lin discloses a magazine firmly mounted to the barrel which functions as the head piece. Moreover, contrary to the Examiner's assertions, one skilled in the art would not have known to provide the electrical device of Olvera with the feeding system of the pneumatic nailer of Lin to arrive at the solution of the claimed invention. For example, the feeding system of Lin does not show a proper clamping system ensuring a sufficient holding force in the moment when the drive-in tool engages with the respective fastener.

However, by using the device claimed in claim 1, in a changing profile direction, the operator only has to turn the head piece to be able to continue his mounting direction in a comfortable manner.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness.

MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that

one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, an that that teachings of the prior should, “in and of

themselves and without the benefits of Appellant's disclosure (emphasis in the original text) make the invention as a whole, obviously." In *re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in Claim 1, obvious, and the present invention is patentable over such referenced.

Claims 2-8 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



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